



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/365,241	07/30/99	BRODIN	T 003300-581

021839 HM22/0614  
BURNS DOANE SWECKER & MATHIS  
P O BOX 1404  
ALEXANDRIA VA 22313-1404


EXAMINER	
WESSENDORF, T	
ART UNIT	PAPER NUMBER
1627	9
DATE MAILED:	06/14/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No. <b>09/365,241</b>	Applicant(s) <b>Brodin et al</b>
Examiner <b>T. Wessendorf</b>	Group Art Unit <b>1627</b>



- Responsive to communication(s) filed on \_\_\_\_\_
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

- Claim(s) 1-60 \_\_\_\_\_ is/are pending in the application
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims 1-60 \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - All  Some\*  None of the CERTIFIED copies of the priority documents have been
    - received.
    - received in Application No. (Series Code/Serial Number) \_\_\_\_\_
    - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152
- FAX TRANSMISSION PAPER

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1627

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-57, drawn to a method of acquiring (identifying) binding structures against a target structure, classified in class 435, subclass 6.
- II. Claims 58-60, drawn to a binding structures, classified in class 530, subclasses 330,350 and 380+.

Art Unit: 1627

2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different products as recited in e.g., claim 5.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, because of their recognized divergent subject matter, and the search required for Group I is not required for Group II, especially with respect to literature searches, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

- A. Binding structures:
  - 1. Monoclonal antibodies
  - 2. Protein

Art Unit: 1618

3. Peptide

4. Organochemical entities

If applicants elect 2 or 3 above, applicants are required to specifically elect a protein or peptide species.

B. Process

1. Physiological

2. Pathological

3. Tissue and/or Cell development

4. Drug response

5. Enzyme process

If applicants elect 2, applicants are further required to elect whether said pathological process is inflammation, tumor deposit etc. as recited in e.g., claim 10.

C. Target (either whole or fragment)

1. Antigen

2. Epitope

3. Ligand

4. Receptor

6. Adhesion molecules

7. Matrix or matrix associated molecules

Art Unit: 1618

Additionally, applicants would have to elect whether the structures of these target are based on protein, carbohydrate, nucleic acid or lipid as recited in e.g., claim 23.

D. Synthesis

1. Bacterial cells
2. PCR
3. Chemical

The species under each of subgroups A-D are structurally distinct and would possibly have different mode of actions or operations. Each of the different species would therefore require different patentability determinations under the different statutes.

If applicants elect Group I, applicants are required to elect only the species recited under Subgroups A and C.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must

Art Unit: 1618

be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1627.

Certain papers related to this application may be submitted to Art Unit 1627 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 O.G. 61 (November 16, 1993) and 1157 O.G. 94 (December 28, 1993) (see 37 C.F.R. 1.6(d)). The official fax telephone numbers of the Group are (703)308-7924. NOTE: If applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Wessendorf whose telephone number is (703) 308-3967. The examiner can normally be reached on Mon. to Fri. from 8 to 4:30.

Art Unit: 1618

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat Ph.D., can be reached on (703) 308-0570.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

tdw

6/12/00

*T. W. W. W.*

*Patent Examiner*